FILE COPY

In the

Supreme Court of the United States

OCTOBER TERM, 1948

No. 68

VULCAN CORPORATION,

Petitioner,

v.

INTERNATIONAL SHOE MACHINERY CORPORATION ET AL.,

Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

HERMAN T. GAMMONS,
ROBERT L. THOMPSON,
Counsel for Respondents.

L. H. LANE COMPANY, LAW PRINTERS, 221 HIGH STREET, BOSTON, MASS.

INDEX.

	Page
I. The Issue	2
II. Petitioner's Case	2
III. Rule 56 Applicable to Patent Cases	3
IV. No Genuine Issue as to Any Material Fact	4
V. Conclusion	6

TABLE OF CASES.

Arnstein v. Porter, 154 F. (2d) 464, 468	2
Cohen v. Eleven West 42d Street, Inc., 115 F. (2d) 531, 532	2
Doehler Metal Furniture Co., Inc. v. United States, 149 F. (2d) 130, 135	2
Heald v. Rice, 104 U. S. 737	5
Market Street Cable Ry. Co. v. Rowley, 155 U. S. 621, 625	5
McElwain v. Wickwire Spencer Steel Co., 126 F. (2d) 210, 211	2
Milcor Steel Company v. George A. Fuller Company, 122 F. (2d) 292; 316 U. S. 143	4
Parmelee v. Chicago Eye Shield Co., 157 F. (2d) 582, 585	2
Sanitary Refrigerator Company v. Winters, 280 U. S. 30, 36	5
Singer Co. v. Cramer, 192 U. S. 265–275	5
Toebelman v. Missouri-Kansas Pipe Line Co., 130 F. (2d) 1016, 1018	2
United States v. Esnault-Pelterie, 303 U. S. 26, 30	5
Weisser v. Mursam Shoe Corporation, 127 F. (2d) 344, 346	2
Whitaker v. Coleman, 115 F. (2d) 305, 306	2

In the

Supreme Court of the United States.

OCTOBER TERM, 1946.

No. 938.

VULCAN CORPORATION, PETITIONER,

v.

INTERNATIONAL SHOE MACHINE CORPORATION ET AL., RESPONDENTS.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

The petition and brief in support thereof, do not show that this case comes within the provisions Sect. 5(b) of Rule 38, of this Court.

This case does not present a situation wherein one Circuit Court of Appeals has rendered a decision in conflict with another Circuit Court of Appeals on the same matter; it does not present a question upon which varying views have been expressed by different Circuit Courts of Appeals; it does not present any unsettled legal proposition; nor does it present any question of general or public interest.

Instead, this is an ordinary patent case involving the usual issue of infringement, disposed of by summary judgment under Rules 12(c) and 56 of the Rules of Civil Procedure. The patent in suit has never previously been litigated.

THE ISSUE.

The only reason advanced for granting the petition (Petition, page 2) is that because of an alleged "difference in the grounds upon which the United States Circuit Courts of Appeals of the several Circuits have sustained motions for summary judgments" there is a need to establish a rule to be followed by these Courts in granting motions for summary judgments.

Ostensibly the petition is a request for a ruling as to the law of summary judgments. In reality it is only an effort to have this Court rule as to whether the accused device infringes the patent in suit.

PETITIONER'S CASE.

In support of its allegation of a difference in the practice of the various Circuit Courts of Appeals in respect to motions for summary judgment, Petitioner cites decisions (with quotations) from the Second, Third, Fifth and Eighth Circuits.

Not one of the cited decisions from the above Circuits concerns a patent or a patent infringement matter. *Arnstein* v. *Porter,* 154 F. (2d) 464, 468, is a copyright infringement case; *McElwain* v. *Wickwire Spencer Steel Co.,* 126 F. (2d) 210, 211, is a case under the Workmen's Compensation Law; *Doehler Metal Furniture Co., Inc.* v. *United States,* 149 F. (2d) 130, 135, is a suit on a contract for sale; *Weisser* v. *Mursam Shoe Corporation,* 127 F. (2d) 344, 346, is an action for recovery of rent; *Cohen* v. *Eleven West 42nd Street, Inc.,* 115 F. (2d) 531, 532, is a bankruptcy case; *Parmelee* v. *Chicago Eye Shield Co.,* 157 F. (2d) 582, 585, is an action on an account for goods sold and delivered; *Whitaker* v. *Coleman,* 115 F. (2d) 305, 306, is an action for damages for accidental death; *Toebelman* v. *Missouri-Kansas Pipe Line Co.,* 130 F. (2d) 1016, 1018, is a stockholder's derivative suit.

All of the above cases *agree* that summary judgment is

applicable where there is no genuine issue as to any material *fact.*

Petitioner then quotes from the decision of the District Court in the instant case in support of its argument that the District Court and the Court of Appeals for the First Circuit, in the case at Bar, did not follow the general practice as to summary judgments. The quotation is as follows:

> "Since the accused structure does not contain all the elements of claim 1 (that is, it does not include the toggle and stop) or their equivalents, the accused last is not, and could not be shown by any evidence to be an infringement."

The most that can be made from the above quotation is that the District Court was confident that there was no genuine issue as to any material fact and that the moving party was entitled to a judgment as a matter of law (Rule 56).

Petitioner fails utterly to show that the Courts of the First Circuit disagree with or fail to recognize or to follow the general practice which is in conformity with the express language of Rule 56. In particular, Petitioner has completely failed to point to any genuine issue as to any material fact.

RULE 56 IS APPLICABLE IN PATENT INFRINGEMENT CASES.

The notes of the Advisory Committee appended to Rule 56 of the Rules of Civil Procedure state:

> "This rule is applicable to all actions, including those against the United States or an officer or agency thereof.
>
> "Summary judgment procedure is a method for promptly disposing of actions in which there is no genuine issue as to any material fact."

Rule 56 does not specifically except patent cases from its application and the Courts have consistently recognized the rule as applicable to patent infringement cases. Among others is *Milcor Steel Company* v. *George A. Fuller Company,* 122 F. (2d) 292, which came up to this Court on certiorari and is reported at 316 U. S. 143. While the specific question of the applicability of a motion for summary judgment to a patent infringement case was not passed upon by this Court, the Court remarked, without comment, that the District Court had entered summary judgment for the Defendants and that the District Court had been affirmed by the Circuit Court of Appeals. The Supreme Court affirmed the judgment of the District Court which dismissed the case for invalidity of the patent claims.

THERE IS NO GENUINE ISSUE AS TO ANY MATERIAL FACT.

In the instant case the accused device (Ex. No. 1) in physical form was before the District Court by stipulation (R. p. 10); an agreed statement (Ex. No. 2) of its structure and mode of operation was before the District Court by stipulation (R. p. 10); and the file wrapper and contents of the patent in suit was before the Circuit Court of Appeals by stipulation as a physical exhibit (R. p. 23). The subject matter is of a simple nature, easily understood by anyone.

Petitioner did not, in its brief before the Circuit Court of Appeals, nor does it in its petition to this Court, point to any disputed issue of *fact* or aver that any material fact was unknown to the District Court but only suggests that the District Court erred in ruling, upon the agreed facts, that the accused last was not the equivalent of the claimed structure. At page 8 of the petition, Petitioner tacitly admits that the question of equivalency is the real issue.

Equivalency, under the conditions here present, is a question of law, not fact, hence this case was properly disposed of by summary judgment in applying the law of equivalency to the agreed facts.

In *Sanitary Refrigerator Company* v. *Winters,* 280 U.S. 30, 36, in considering the question of patent infringement this Court remarked:

> "Furthermore, upon the undisputed evidence the question of infringement resolves itself in each case into one of law, depending upon a comparison between the structure disclosed on the face of the patent and the device shown in the Dent latch, and the correct application thereto of the rule of equivalency. Compare *Singer Company* v. *Cramer,* 192 U.S. 265, 275."

Singer v. *Cramer,* referred to in the foregoing quotation, was also a patent infringement case. In that case this Court remarked:

> "As in each of the patents in question it is apparent from the face of the instrument that extrinsic evidence is not needed to explain terms of art therein, or to apply the descriptions to the subject matter, as we are able from mere comparison to comprehend what are the inventions described in each patent and from such comparison to determine whether or not the Diehl device is an infringement upon that of Cramer, the question of infringement or no infringement is one of law and susceptible of determination on this writ of error. *Heald* v. *Rice,* 104 U.S. 737; *Market Street Cable Ry. Co.* v. *Rowley,* 155 U.S. 621, 625."

In *United States* v. *Esnault-Pelterie,* 303 U.S. 26, 30 (a patent infringement suit brought in the Court of Claims), the Supreme Court remarked:

> "We are not unmindful of the rule that where, with all the evidence before it, it appears that no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structures and extrinsic evidence is not needed for purposes of explanation, or evaluation of prior art, or to resolve questions

of application of descriptions to subject matter, the questions of invention and infringement may be determined as questions of law." Citing *Heald* v. *Rice, supra; Singer Manufacturing Company* v. *Cramer, supra;* and *Sanitary Refrigerator Company* v. *Winters, supra.*

CONCLUSION.

A large part of Petitioner's brief is devoted to argument, as to whether, under the facts of the case at bar, the accused device actually is the (patentable) equivalent of that claimed in the patent in suit. It would seem that this portion of Petitioner's brief is wholly irrelevant as respects the single reason advanced by Petitioner in support of its petition (Petition, p. 2). The petition really seeks to have this Court rule upon the question of infringement in the case at bar. The authorities cited by Petitioner are *inapt* and there is no substance to Petitioner's request.

It is respectfully submitted that the petition fails to suggest any proper ground for the exercise by this Honorable Court of its supervisory authority; in particular that it fails to show any conflict of opinion among the several Circuit Courts as to "the present law on Summary Judgments" or any error by the Circuit Court of Appeals for the First Circuit in respect to summary judgment procedure.

We submit that the Petition should be denied.

Respectfully,

HERMAN T. GAMMONS,
ROBERT L. THOMPSON,
Counsel for Respondents.

February, 1947.